

REMARKS

The present application was filed on January 5, 2001 with claims 1-22. Claims 1-22 remain pending and claims 1, 10, 21 and 22 are independent.

In the outstanding Office Action dated January 4, 2005, the Examiner: (i) rejected claims 1-4, 8-13, 17-19, 21 and 22 under 35 U.S.C. §102(b) as being anticipated by Applicants' Admitted Prior Art (hereinafter "AAPA"); and (ii) rejected claims 5, 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of U.S. Patent No. 6,484,247 to Gendron et al. (hereinafter "Gendron").

With regard to the rejection of claims 1-4, 8-13, 17-19, 21 and 22 under 35 U.S.C. §102(b) as being anticipated by AAPA, Applicants assert that such claims are patentable for at least the reasons presented below.

It is well-established law that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." See, e.g., *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See also, M.P.E.P. §2131. Applicants assert that AAPA fails to teach or suggest each and every element respectively recited in claims 1-4, 8-13, 17-19, 21 and 22 and, thus, the §102(b) rejection clearly fails to meet the above legal requirements for anticipation. Support for this assertion follows.

Independent claim 1 recites a computer-based method of performing automated distribution of a software package to one or more target machines in one or more regions of a distributed network of target machines. A base software package is prepared for each of the one or more regions. The software package preparation is capable of being based on: (i) policy data indicating which of the one or more regions are candidates for receiving the software package; (ii) dependency information indicating requisites for a service provided by the software package; and (iii) configuration information for each of the candidate regions. The base software package is distributed to each of the candidate regions of the distributed network, where it is customized. The software package customization is capable of being based on: (i) regional distribution policies; (ii) dependency information specific to one or more roles performed by the target machines in that region; and (iii)

individual target machine configuration information. The software package customized in each of the candidate regions is distributed to at least one of the target machines in the candidate regions of the distributed network. Independent claims 10, 21 and 22 recite similar limitations.

AAPA describes the manual selection of potential distribution targets by a software distribution administrator, in which the administrator prepare software to be distributed to a set of desktop machines. A configuration file is consulted to determine which target machine should receive the new software, and the software package is stored in a package repository. When there is a request for distribution of the software package, the package is downloaded to the distribution server, and distributed by the distribution server to the distribution target computer systems.

Regarding the preparation of the software package, AAPA fails to disclose that the preparation is capable of being based on policy data indicating which of the one or more regions are candidates for receiving the software package. AAPA also fails to disclose that the preparation is capable of being based on dependency information indicating requisites for a service provided by the software package. Finally, in the preparation of the software package, AAPA fails to disclose that the preparation is capable of being based on configuration information for each of the candidate regions. AAPA has no description of candidate regions in a distributed network.

The Examiner contends that policy data and configuration information have to be considered because of the plurality of distribution targets, and that dependency information has to be considered because of different software updates. The Examiner further contends that the claimed features are expressly or implicitly anticipated by features shown in FIG. 1 and the associated discussion in the background. Applicants assert that none of the claimed features regarding the preparation of the software package are explicitly anticipated since the background only states that the administrator prepares a new software item to be distributed to a set of desktop machines, preferably in a machine dedicated to, and containing the requisite operating system components for, building software packages. Further, this preparation is being performed by a programmer, and thus, the method is not automated, as recited in the independent claims of the present invention.

The Office Action also fails to provide an argument supporting inherency. In any case, according to the Federal Circuit, “[i]nherency does not embrace probabilities or possibilities.”

Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1297, 63 USPQ2d 1597 (Fed. Cir. 2002). Further, an inherent anticipation requires that the missing descriptive material is necessarily present, and not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Thus, the alleged inherent feature must flow from the reference, and it is not sufficient to state that the alleged inherent feature could flow from the reference. AAPA does not disclose the material necessary to support a rejection based on inherency.

Regarding the customizing of the software package at each of the candidate regions, AAPA fails to disclose any customization steps. In addition, AAPA fails to disclose that the software package customization is capable of being based on regional distribution policies. AAPA also fails to disclose that the customization is capable of being based on dependency information specific to one or more roles performed by the target machines in that region. Finally, in the customization of the software package, AAPA fails to disclose that the preparation is capable of being based on individual target machine configuration information.

The Examiner contends that this customization is disclosed in step 6 of FIG. 1 and the related discussion in AAPA. However, step 6 only relates to the distribution of the package and the related discussion only states that “the package is distributed by the distribution server 18 to the distribution target computer systems 20-1, 20-2, . . . , 20-N.” Thus, Applicants assert that none of the claimed features regarding the customization of the software package are explicitly anticipated. Further regarding implicit anticipation, AAPA does not disclose the material necessary to support a rejection based on inherency, as described above.

Regarding the distribution of software packages, AAPA fails to disclose the distribution of the base software package to candidate regions of the distributed network, and the distribution of customized software packages to target machines in the candidate regions. AAPA includes only one distribution step, from a server to targets, in step 6 of FIG. 1. Further, AAPA does not distinguish between a base software package and a customized software package.

Applicants assert that dependent claims 2-4, 8, 9, 11-13, 17-19 are patentable at least by virtue of their dependency from independent claims 1 and 10. Further, Applicants assert that dependent claims 2-4, 8, 9, 11-13, 17-19 recite patentable subject matter in their own right.

Accordingly, withdrawal of the rejection to claims 1-4, 8-13, 17-19, 21 and 22 under 35 U.S.C. §102(b) is therefore respectfully requested.

With regard to the rejection of claims 5, 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over AAPA and Gendron, Applicants assert that such claims are patentable at least by virtue of their dependency from independent claims 1 and 10, and also recite patentable subject matter in their own right. The combination of AAPA and Gendron also fails to disclose the preparation, customization and distribution limitations recited in the independent claims of the present invention. Accordingly, withdrawal of the rejection to claims 5, 14 and 20 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-22 are in condition for allowance, and respectfully request withdrawal of the §102(b) and §103(a) rejections.

Respectfully submitted,



Date: April 1, 2005

Robert W. Griffith
Attorney for Applicant(s)
Reg. No. 48,956
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-4547